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**MAY 16 2008**

**OFFICE OF PETITIONS**

In re Application of :  
Kim et al. :  
Application Number: 10/613199 : ON PETITION  
Filing Date: 07/03/2003 :  
Attorney Docket Number: 03/139 :

This is a decision on the petition under 37 CFR 1.137(a), filed on April 16, 2008, which is treated, in the alternative, under the unintentional provisions of 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is DISMISSED.

The petition under 37 CFR 1.137(b) is GRANTED.

The application became abandoned on June 16, 2007, for failure to timely a reply to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on May 15, 2007, which set a one (1) month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on April 10, 2008.

A grantable petition under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The petition lacks item (3), above.

As to item (3), the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".<sup>1</sup> Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably, prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be

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<sup>1</sup> 35 U.S.C. § 133.

unavoidable, all other conditions of promptness in its rectification being present.<sup>2</sup>

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).<sup>3</sup> Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.<sup>4</sup>

Petitioner asserts that a response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on May 15, 2007 was timely filed, along with a return receipt postcard, but that the return receipt postcard was never stamped by the USPTO and returned.

A copy of the reply to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on May 15, 2007 is included with the subject petition.

While it is unfortunate if petitioner did not receive the return postcard stamped with the Office receipt date, the showing of record does not rise to the level of unavoidable delay because the showing of record is that petitioners did not avail themselves of the procedures set forth at 37 CFR 1.8 and 1.10 in that petitioners did not file the reply by first-class mail or "Express Mail Post Office to Addressee Service" with the United States Postal Service (USPS).

In this regard, although petitioner states in the petition that "[a]pplicant mailed the Reply with the certificate of mailing on time," no certificate of mailing in accordance with 37 CFR 1.8 or 1.10 is located on the copy of the reply to the Notification of

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<sup>2</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

<sup>3</sup> See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

<sup>4</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Non-Complaint Appeal Brief mailed on May 15, 2007. The showing of record, therefore, is that petitioner did not file the reply in accordance with 37 CFR 1.8 or 1.10.

Petitioner's failure to file the reply at issue in compliance with 37 CFR 1.8 or 1.10 precludes a finding that the delay was unavoidable. A "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay.<sup>5</sup>

As the showing of record does not rise to the level of unavoidable delay, the petition under 37 CFR 1.137(a) is dismissed.

**PETITION UNDER 37 CFR 1.137(b)**

It is noted that petitioner states:

If the US Patent Office finds that the above grounds do not support a petition to revive on the grounds of unavoidability then petitioner requests that the abandonment be found to be unintentionable (*sic*).

As it is clear that petitioner is requesting treatment in the alternative under the unintentional provisions of 37 CFR 1.137(b), despite the miscaptioning of the word "unintentional," the petition will be treated in the alternative under the unintentional provisions of 37 CFR 1.137(b). Petitioner **must** inform the Office if this is an incorrect interpretation.

The petition is granted.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

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<sup>5</sup> See Krahn v. Comm'r, 15 USPQ2d 1823, 1825 (E.D. Va. 1990); see also, MPEP 711.03(c) (III) (C) (2).

The petition fee of \$1,540.00 is being charged to counsel's deposit account as authorized in the letter filed with the petition on April 16, 2008.

Receipt of the "Summary of Claimed Subject Matter 37 CFR 41.37(c)(1)(v)" filed as the required reply, is acknowledged.

The application is referred to Technology Center Art Unit 2832 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



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